

Remarks

Reconsideration of the above identified application in view of the present amendment is respectfully requested.

Claims 1 -24 are pending the present application. Claims 20-23 are allowed. Claim 1 is rejected under 35 U.S.C. 102(b). Claims 1, 14-16, 18, and 19 are rejected under 35 U.S.C. 103(a). Claims 1-19 are rejected under the judicially created doctrine of double patenting. Claims 2-13 are cancelled. Applicant reserves the right to present the subject matter of these claims in a continuing application.

New claims 24-41 are presented for examination. Claim 24 corresponds to the incorporation of the limitations of claim 2 into claim 1. Dependent claims 25-41 incorporate the limitations of claims 3-13 which depend from claim 2 and the limitations of claim 14-19 which depend directly from claim 1.

The present application is directed toward a light curable composition with consists essentially of a photocurable organic mixture; a photoinitiator; silver powder, and silver flakes. The silver flakes are present in an amount of at least 20%. The applicant has surprisingly discovered a composition capable of forming a conductive layer that incorporates high amount of silver flakes. This results in conductive layers with improved electrical conductivity. Claim 1 of the present invention uses the transitional phrase "consisting essentially of" which limits the scope of a claim to the elements "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. (MPEP 2111.03, quoting *In re Herz*, 537 F.2d 549, 551-52 (CCPA 1976). Accordingly, independent claim 1 and its dependent claims 2-19 are limited to the elements recited and to ingredients that do not materially affect the photocurable silver composition.

1. Rejection under 35 U.S.C. 102(b)

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by JP05-311103.

JP05-311103 discloses a printing ink that comprises a resin, a silver component, and a flux component. The silver component is described as “pref. 0.05-1.0 micron dia. spherical powder and/or 0.5-5 micron flaky powder, and Ag contg. organic metal cpd. . . .” (JP05-311103 Abstract, emphasis added) The silver component of claim 1 of the present application is silver powder and “silver flakes in an amount of at least 20% relative to the weight of the silver powder.” (claim 1) Moreover, since claim 1 uses the transitional phrase “consisting essentially of” the incorporation of an “Ag contg. organic metal cpd” as disclosed by JP05-311103 is precluded. Accordingly, Applicant believes claim 1 is allowable and requests that the rejection under 102(b) be withdrawn.

2. Rejection under 35 U.S.C. 103(a)

Claims 1, 14-16, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP05-311103.

Applicant believes that the 103(a) rejection should be withdrawn for the same reasons set forth above for the 102(b) rejection. The silver component of claim 1 of the present application is silver powder and “silver flakes in an amount of at least 20% relative to the weight of the silver powder.” (claim 1) Again, since claim 1 uses the transitional phrase “consisting essentially of” the incorporation of an “Ag contg. organic metal cpd” as disclosed by JP05-311103 is precluded. Accordingly, independent claim 1 and its dependent claims 14-16, 18, and 19 are allowable.

2. Double patenting

Claims 1-19 are rejected under the judicially created doctrine of double patenting.

Applicant is filing a terminal disclaimer with the present amendment. Accordingly, the rejection under the judicially created doctrine of double patenting should be removed.

Conclusion

Applicant has made a genuine effort to respond to each of the Examiner's objections and rejections in advancing the prosecution of this case. Applicant believes that all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested. If any additional issues need to be resolved, the Examiner is invited to contact the undersigned at his earliest convenience.

A check is enclosed to cover the additional claims filing fee of \$54.00. The Commissioner is authorized to charge any deficiencies as a result of the filing of this paper to Deposit Account No. 02-3978 as authorized by the original transmittal letter in this case.

Respectfully submitted,

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